## REMARKS

### I. Overview

Claims 7-11 and 16-27 are pending in the present application. The outstanding issues raised in the current Office Action are as follows:

- Claims 16-27 are withdrawn from consideration as being directed to a non-elected invention;
- Claims 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,600,598 (*Foerster*);
- Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Foerster* in view of U.S. Patent Publication No. 2003/0095036 (*Wasaki*);
- Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Foerster* in view of U.S. Patent No. 5,834,925 (*Chesavage*); and
- Claims 7 and 10 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,760,276 (*Lethellier*) in view of U.S. Patent No. 4,924,170 (*Henze*).

In response, Applicant respectfully traverses the Examiner's constructive election and claim rejections, and requests reconsideration and withdrawal in light of the remarks presented herein

### II. Reconsideration of Restriction/Constructive Election

Claims 16-27 have been withdrawn from consideration as being directed to a non-elected invention. *Office Action* at p. 3. Applicant respectfully traverses the Examiner's constructive election of claims 7-11, and respectfully asserts that all pending claims should be examined.

In general, there are two criteria for a proper restriction. First, the inventions must be independent or distinct as claimed. Second, a search and examination of all the claims in the application must place a serious burden on the Examiner. M.P.E.P. § 803. As discussed below, the Examiner failed to properly establish that claims 16-27 are independent or distinct from

claims 7-11. Moreover, the Examiner also failed to establish that the search and examination of claims 7-11 and 16-27 would place a create a serious burden.

A. The inventions of claims 7-11 and 16-27 are not independent or distinct

The Examiner states that claims 16-27 are independent or distinct from "Applicant's originally filed (currently canceled) apparatus and system claims . . . ." *Office Action* at p. 2. In response, Applicant respectfully asserts that the proper inquiry in evaluating whether restriction is necessary would require a comparison between claims 16-27 and 7-11, not between claims 16-27 and other previously canceled claims that are no longer pending before the Office.

The basis for restriction practice is found in 35 U.S.C. § 121, which states that "[i]f two or more independent and distinct inventions ***are claimed*** in one application, the Director may require the application to be restricted to one of the inventions." *See* M.P.E.P. § 802 (emphasis added). In other words, restriction may only apply when independent and distinct the inventions are actually being claimed in the application. Here, the canceled claims are no longer pending, and thus they are not relevant to a restriction determination.

With respect to the pending claims, Applicant submits that claims 16-27 and 7-11 recite systems and a method of using those systems, respectively. *See* M.P.E.P. § 806.05(h). Further, "[a] product and process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process." *Id.*

In this case, Applicant notes that the Examiner has not been able to show either (A) or (B). *See Office Action* at p. 2 and 3. Therefore, Applicant asserts that distinctiveness as between claims 7-11 and 16-27 has not been properly established.

B. No "serious burden" has been established

Even if the inventions of claims 7-11 and 16-27 are found to be independent or distinct from each other, "[i]f the search and examination of an entire application can be made ***without serious burden***, the examiner ***must examine*** it on the merits . . . ." M.P.E.P. § 803 (emphasis added). And, to establish a serious burden, "the examiner ***must show*** by appropriate explanation one of the following: (A) Separate classification thereof . . . ; (B) A separate status in the art when they are classifiable together . . . ; (C) A different filed of search . . . ." M.P.E.P. § 808.02 (emphasis added).

In this case, ***the Examiner did not attempt to establish that a serious burden would result if the restriction were not made.*** *See Office Action* at pp. 2 and 3. Applicant asserts that similar elements to those required to be searched and examined for the constructively elected claims 7-11 are also present claims 16-27, and thus a search and examination of these similar elements will be required anyway. Therefore no serious burden would arise if claims 16-27 were not restricted from claims 7-11. Accordingly, Applicant respectfully requests all pending claims be examined in a subsequent office action.

## III. Claims Rejections Under 35 U.S.C. § 102(b) over *Foerster*

Claims 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Foerster*. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

In order to anticipate a claim under 35 U.S.C. § 102, a single reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In fact, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Furthermore, for a reference to be anticipatory, "[its] elements must be arranged as required by the claim." *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2131. As

described in detail below, Applicant respectfully asserts that *Foerster* does not teach or suggest every element recited in the claims.

Claim 7 recites,

> 7. A method for supplying power to an electronic load comprising:
>
> connecting a plurality of power supplies in parallel;
>
> setting, via a power selector circuit, a maximum effective voltage for each of said plurality of power supplies to cascade from a highest effective voltage for a first of said plurality to a lowest effective voltage for a last of said plurality; and
>
> interfacing said plurality of power supplies with said electronic load through said power selector circuit.

*Foerster* does not teach setting a maximum effective voltage for each of a plurality of power supplies. In addition, *Foerster* does not teach interfacing the plurality of power supplies with a load through the power selector circuit.

Applicant notes that *Foerster* discloses a power supply system having multiple power supply modules PS1'—PS4' providing power to loads L1'—L7'. *See e.g., Foerster* at col. 3, ln. 64—col. 4, ln. 4; Figures 2 and 3. It is clear that *Foerster*' loads L1'—L7' are directly connected to its power supplies PS1'—PS4'. Thus, *Foerster* does not teach or suggest, at least, "interfacing said plurality of power supplies with said electronic load through said power selector circuit," as recited in claim 7.

Moreover, *Foerster* does not teach "setting, via a power selector circuit, a maximum effective voltage for each of said plurality of power supplies . . ." either. In fact, there is nothing in *Foerster* that indicates that the effective voltage of power supply modules PS1'—PS4' is set or otherwise controlled in any way. To aid the Examiner in better understanding the operation of *Foerster*'s circuit, Applicant points to a passage which states that:

> [i]n the event the load L5', for example, supplies more current that is drawn by loads L2' and L6', the excess current, instead of being shunted through a resistor, is applied through the switch 32 to the transformer winding 22 for redistribution to one of other levels requiring a current source.

*Foerster* at col. 4, lns. 31-36. In other words, rather than waste power through a shunt resistor when a load changes, *Foerster*'s circuit operates to re-distribute that "excess current" to other loads using transformer 20 and switches 28, 32, 34, and 36. *See e.g.*, *Foerster* at Figure 2. However, *Foerster*'s redistribution of electrical current due to load changes does not set the voltages of any of power supply modules PS1'—PS4', which in fact remain constant. *See Foerster* at col. 3, lns. 67—70.

Therefore, Applicant respectfully submits that *Foerster* does not teach every element of claim 7. Claim 8 depends from claim 7 and is patentable at least for the same reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of record with respect to claims 7 and 8.

## IV. Claims Rejections Under 35 U.S.C. § 103(a) over *Foerster* in view of *Wasaki*

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Foerster* in view of *Wasaki*. Applicant traverses the rejection and asserts that the claim is allowable, at least, for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the reference (or references when combined) must teach or suggest all the claim elements. *Id.* Applicant asserts that the rejection does not satisfy the basic criteria.

A. Insufficient Motivation

The rejection of claim 9 should be withdrawn because there is insufficient motivation for the combination of *Wasaki* with *Foerster*. In support for the combination, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Foerster* to include the use of impedance selection to maximize the power output to the load." *Office Action* at p. 4. However, *Foerster*'s power supply already operates to maximize the output to its loads. *See Foerster* at Abstract; col. 1, lns. 43-75. Applicant respectfully asserts that a person of ordinary skill in the art would not be motivated to "add" a power output maximization feature into *Foerster* because *Foerster* already has that feature.

More importantly, contrary to the Examiner's contention, *Wasaki* does not teach an "impedance selection" circuit, but rather it teaches an "impedance matching" circuit. *E.g.*, *Wasaki* at ¶¶ [0060]; Figure 1, element 20. The Examiner has provided no indication of how an "impedance matching" circuit would be used to benefit *Foerster* in any way, and Applicant asserts that it would not. Neither the applied art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Foerster* with *Wasaki*.

Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 9.

B. Lack of All Claimed Elements

As noted above, *Foerster* fails to teach or suggest every element recited in claim 7. The Examiner does not rely upon *Wasaki* as teaching or suggesting these elements, and Applicant asserts that *Wasaki* does not teach or suggest such features. Therefore, the combination of *Foerster* with *Wasaki*, even if proper, fails to teach or suggest all of the elements of independent claim 7. Dependent claim 9 depends from claim 7, thus inheriting all the features of that independent claim. Consequently, the combination of *Foerster* with *Wasaki*, even if proper, also

fails to teach or suggest all of the elements of dependent claim 9. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 9.

## V. Claims Rejections Under 35 U.S.C. § 103(a) over *Foerster* in view of *Chesavage*

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Foerster* in view of *Chesavage*. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

### A. Insufficient Motivation

The rejection of claims 10 and 11 should be withdrawn because there is insufficient motivation for the combination of *Chesavage* with *Foerster*. In support for the combination, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Foerster* to include such a latching to meet load demands." *Office Action* at p. 5. However, *Foerster*'s itself teaches a latching mechanism to meet load demands. *See Foerster* at col. 4, lns. 25-36; Figure 3, items 28", 32", 34", and 36". Applicant respectfully asserts that a person of ordinary skill in the art would not be motivated to "add" a latching mechanism into *Foerster* because *Foerster* already has such a mechanism.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the applied art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. In this case, neither the applied art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Chesavage* with *Foerster*. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 10 and 11.

B. Lack of All Claimed Elements

As noted above, *Foerster* fails to teach or suggest every element recited in claim 7. The Examiner does not rely upon *Chesavage* as teaching or suggesting these elements, and Applicant asserts that *Chesavage* does not teach or suggest such features. Therefore, the combination of *Foerster* with *Chesavage*, even if proper, fails to teach or suggest all of the elements of independent claim 7. Dependent claims 10 and 11 depend from claim 7, thus inheriting all the features of that independent claim. Consequently, the combination of *Foerster* with *Chesavage*, even if proper, also fails to teach or suggest all of the elements of dependent claims 10 and 11. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 10 and 11.

## VI. Claims Rejections Under 35 U.S.C. § 103(a) over *Lethellier* in view of *Henze*

Claims 7 and 10 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lethellier* in view of *Henze*. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

A. Insufficient Motivation

The rejection of claims 7 and 10 should be withdrawn because there is insufficient motivation for the combination of *Lethellier* with *Henze*. In support for the combination, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Lethellier* in view of *Henze* to cascade the plurality of supplies in order of effective voltage in order to supply the correct voltage to the load." *Office Action* at p. 6. However, Applicant asserts that *Lethellier* already provides correct voltage to a load, as can be immediately seen from the fact that each of *Lethellier*'s loads is directly connected to each of its power supplies. *See Lethellier* at col 3, lns. 3-12; Figure 2.

Again, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the applied art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). In this case, neither the applied art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Lethellier* with *Henze*. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 7 and 10.

B. Lack of All Claimed Elements

The Examiner relies upon *Lethellier* as meeting every feature recited in claim 7 with the exception of "the cascading of supplies from highest voltage to lowest voltage." *Office Action* at pp. 5 and 6. Similarly as noted with respect to *Foerster*, *Lethellier* discloses a power supply system having multiple power supply sets SET 1—SET 3 providing power to loads L1—L3. *See e.g.*, *Lethellier* at col. 2, ln. 65—col. 4, ln. 12; Figure 2. And, as with the *Foerster* analysis provided above, it is very clear that *Lethellier*'s loads L1—L3 are directly connected to power supply sets SET 1—SET 3. *Id.* Thus, *Lethellier* does not teach or suggest, at least, "interfacing said plurality of power supplies with said electronic load through said power selector circuit," as recited in claim 7.

Neither does *Lethellier* teach or suggest "setting, via a power selector circuit, a maximum effective voltage for each of said plurality of power supplies . . ." In fact, there is nothing in *Lethellier* that indicates that the effective voltage of power supply sets SET 1—SET 3 is set or otherwise controlled in any way. The Examiner does not rely upon *Henze* as meeting these features, and Applicant asserts that *Henze* does not meet such features. Thus, the combination of *Lethellier* with *Henze*, even if proper, does not teach or suggest every element recited in claim 7.

Dependent claim 10 depends from claim 7, thus inheriting all the features of that independent claim. Consequently, the combination of *Lethellier* with *Henze*, even if proper, also fails to teach or suggest all of the elements of dependent claim 10. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 7 and 10.

## VII. Conclusion

In view of the above remarks, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 200300353-1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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